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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/727,835 | 11/30/2000 | Eric Edwards | 80398.P356 | 3923 |

7590 07/02/2004

Dennis A. Nicholls
BLAKELY, SOKOFLOFF, TAYLOR & ZAFMAN LLP
7th Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025

| EXAMINER | |
|---|---|
| CHUONG, TRUC T | |
| **ART UNIT** | **PAPER NUMBER** |
| 2174 | 8 |

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 09/727,835 | EDWARDS ET AL. |
| | Examiner | Art Unit |
| | Truc T Chuong | 2174 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *30 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This communication is responsive to the communication, filed 03/30/04.

2. Claims 1-61 are pending in this application. Claims 1, 9, 16-18, 24, 32, 40, 46, and 55 are independent claims. This action is made non-final.

3. In view of the Appeal Brief filed on 03/25/04, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-6, 9-14, 16-53, and 55-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerlach, Jr. et al. (U.S. Patent No. 6,484,189 B1) in view of Filo et al. (U.S. Patent No. 6,215,498 B1).

As to claim 18, Gerlach teaches a system for indicating suggested user responses, comprising:

means for loading an image into first image-editing equipment (object editor, col. 8 lines 17-28);

means for determining a set of said image using software (SCORE, col. 8 lines 44-57 and figs. 13-14);

means for displaying an icon in conjunction with said image (col. 33 lines 34-41); and

means for indicating a suggested user response to one of said problem (evaluation, col. 20 lines 50-67); however, Gerlach does not teach using an animated icon to determine a set of quality-related problems of the image. Filo clearly teaches using animated icon or avatar to determine the changes of video and audio information (displaying functional objects in the virtual work environment, and a data base for prestoring computer information and graphics supporting the appearance of the avatars, col. 3 lines 5-23). It would have been obvious at the time of the invention that a person with ordinary skill in the art would want to have the animated icon of Filo in the editor of Gerlach to improve the visual work environment to help a user easily control and interact with the objects.

As to claim 19, Gerlach in view of Filo teaches the system of claim 18, wherein said means for indicating includes means for indicating said suggested user response in response to matching a corrective function within said software with one of said set of quality-related problems (col. 33 lines 34-59).

As to claim 20, Gerlach in view of Filo teaches the system of claim 18, further comprising means for moving said animated icon to second image-editing equipment (saved and attached, col. 30 lines 28-42).

As to claim 21, Gerlach in view of Filo teaches the system of claim 18, wherein said means for displaying includes means for loading said animated icon from a remote server because Gerlach's presentation system is computer authoring systems (col. 1 lines 25-33); therefore, information can be transferred from different sources.

As to claims 1 and 2, they are method claims of system claims 18 and 19. Note the rejections of claims 18 and 19 above.

As to claim 3, this is a method claim of claim system claim 19. Note the rejection of claim 19 above.

As to claim 4, Gerlach in view of Filo teaches the method of claim 1, wherein said indicating includes proffering a tool icon by said animated icon (icon menu, col. 8 lines 65-66 and col. 9 lines 1-12).

As to claim 5, Gerlach in view of Filo teaches the method of claim 1, wherein said indicating includes performing a related editing to said animated icon (col. 9 lines 7-22).

As to claim 6, this is a method claim of system claim 20. Note the rejection of claim 20.

As to claim 9 and 10, they are similar in scope to claims 18 and 19 above; therefore, rejected under similar rationale.

As to claim 11, it is individually similar in scope to claim 19 above; therefore, rejected under similar rationale.

As to claim 12, Gerlach in view of Filo teaches the system of claim 10, wherein said indicator is a tool icon (figs. 7A-D).

As to claim 13, this is a system claim of method claim 5. Note the rejection of claim 5 above.

As to claim 14, the system of claim 10, wherein said animated icon moves to second image-editing equipment (saved and attached, col. 30 lines 28-42).

As to claim 16, this is a product claim of system claim 18. Note the rejection of claim 18 above.

As to claim 17, this is a network claim of system claim 18. Note the rejection of claim 18 above.

As to claim 22, Gerlach in view of Filo teaches the method of claim 1, further comprising receiving said animated icon from second image-editing equipment (copy of the icon from submenu, col. 9 lines 44-54).

As to claim 23, Gerlach in view of Filo teaches the method of claim 22, wherein said animated icon is generated by said second image-editing equipment (creates a module icon and adds the module icon to the presentation, col. 27 lines 25-39).

As to claim 24, Gerlach in view of Filo teaches a method for indicating suggested user responses, comprising:

generating an animated icon on first image-editing equipment (col. 9 lines 44-62); and

sending said animated icon to second image-editing equipment, said animated icon for indicating a suggested user response to one of a set of software determined quality-related problems of an image loaded into said second image-editing equipment (col. 9 line 63-col. 11 line 62).

As to claim 25, Gerlach in view of Filo teaches the method of claim 24, further comprising said second image-editing equipment determining a set of quality-related problems of said image using software, wherein said determining includes matching a corrective function within said software with one of said set of quality-related problems (if-then-else icons, col. 13 line 50-col.14 line 37).

As to claim 26, Gerlach in view of Filo teaches the method of claim 25, further comprising said second image-editing equipment indicating said suggested user response, wherein said indicating includes indicating said suggested user response in response to said matching (col. 14 lines 25-50).

As to claim 27, Gerlach in view of Filo teaches the method of claim 24, further comprising said second image-editing equipment indicating said suggested user response, wherein said indicating includes indicating said suggested user response by proffering a tool icon by said animated icon (the appropriate icon requester, col. 9 line 63-col. 10 line 18).

As to claim 28, Gerlach in view of Filo teaches the method of claim 24, further comprising said second image-editing equipment indicating said suggested user response, wherein said indicating includes performing a related editing to said animated icon (manipulate or edit already created presentations, col. 20 lines 50-67).

As to claim 29, Gerlach in view of Filo teaches the method of claim 24, further comprising receiving said animated icon from said second image-editing equipment (copy of the icon from submenu, col. 9 lines 44-54).

As to claim 30, Gerlach in view of Filo teaches the machine readable medium of claim 16, having stored thereon instructions for indicating suggested user responses, which, when executed by the processor, cause the processor to further perform receiving said animated icon from second image-editing equipment (col. 20 lines 50-67, and col. 9 lines 44-54).

As to claims 31-36, they are product claims of method claims 23-28. Note the rejections of claims 23-28 above respectively.

As to claim 37, it is individually similar in scope to claim 30 above; therefore, rejected under similar rationale.

As to claims 38-39, they are system claims of method claims 22-23. Note the rejections of claims 22-23 above respectively.

As to claims 40-45, they are apparatus claims of method claims 24-29. Note the rejections of claims 24-29 above respectively.

As to claims 46-53, they are system claims of method claims 1, 25-28, 20, and 22-23. Note the rejections of claims 1, 25-28, 20, and 22-23 above respectively.

As to claims 55-60, they are system claims of method claims 24-29. Note the rejections of claims 24-29 above respectively.

6. Claims 7, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerlach, Jr. et al. (U.S. Patent No. 6,484,189 B1) in view of Filo et al. (U.S. Patent No. 6,215,498 B1) as applied above, and further in view of Herz et al. (U.S. Patent No. 5,835,087).

As to claim 7, Gerlach in view of Filo teaches the method of claim 1 wherein said displaying includes loading said animated icon from a remote server (see claim 21 above) but does not teach the animated icon showing banner advertisements that trigger payments to said remote server of said banner advertisements. Herz clearly shows advertisements and electronic payments (col. 40 lines 28-43). It would have been obvious at the time of the invention, a person with ordinary skill in the art would want to have these highly desirable features of advertisements and electronic payments taught by Herz in the Gerlach in view of Filo's system to provide conveniences to all users when using the system.

As to claim 8, Herz also teaches where a user payment on a per-transaction basis is made (a message may also indicate the identity of target object and feedback information, col. 40 lines 37-51). See claim 7 above for motivation.

As to claim 15, this is a system claim of method claim 7. Note the rejection of claim 7 above.

7. Claims 54 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerlach, Jr. et al. (U.S. Patent No. 6,484,189 B1) in view of Filo et al. (U.S. Patent No. 6,215,498 B1) as applied above, and further in view of Hasegawa et al. (U.S. Patent No. 6,169,854 B1).

As to claims 54 and 61, Gerlach in view of Filo clearly teaches the system is a computer system, but Gerlach's system is not located within a camera. Hasegawa teaches a camera having

a display unit that displays operating information by icons regarding the functions of the camera (col. 4 line 56-col. 5 line 14, figs. 1-2, 6, and 8). It would have been obvious at the time of the invention that a person with ordinary skill in the art would want to have these highly controllable features of Hasegawa's camera loading in the modified Gerlach's system to provide more convenient operating features in one display unit for the users.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T Chuong whose telephone number is 703-305-5753. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on 703-308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Truc T. Chuong

06/23/04

Kristine Kincaid

KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100